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EXAMINER

SALL, EL HADJI MALICK

ART UNIT PAPER NUMBER

2157

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/899,494	Applicant(s) AZUMA, TOMIHIKO	
	Examiner El Hadji M. Sall	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/21/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

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1. **DETAILED ACTION**

This action is responsive to the correspondence filed on January 21, 2005. Claims 1-10 are pending. Claims 1-10 represent method of vicariously executing translation of electronic mails for users, and apparatus, system and medium therefor.

2. **Claim Objections**

Claim 8 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim *--should refer to other claims in the alternative only--*. See MPEP § 608.01(n). Accordingly, the claim *--has--* not been further treated on the merits. For purpose of prior art rejection, examiner will construe claim 8 as "a system comprising said provider machine as claimed in claim 3".

Claim 3 is objected to because of the following informalities: Applicant uses "translation judger" on line 2, which is not found in the dictionary. For purpose of prior art rejection, examiner will construe "translation judger" as "translation judging means. Appropriate correction is required.

3. *Claim Rejections - 35 USC § 102*

A person shall be entitled to a patent unless –

(e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being unpatentable over Picoult et al U.S. 6,801,932.

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Picoult teaches the invention as claimed including method and system for remote retrieval of documents (see abstract)

As to claim 1, Picoult teaches a method of vicariously executing translation of electronic mails, comprising

Judging whether translation is required for an electronic mail based on at least one of sender data associated with the electronic mail and addressee data associated with the electronic mail (column 4, lines 19-27, Picoult discloses the data center determine if any translation is required); and

Submitting for translation a part or all of the contents of the electronic mail by an Internet connection provider when it is judged that translation is required (column 4, lines 32-34, Picoult discloses once translation is effected, the message is routed to the identified destination device).

As to claim 2, Picoult teaches the method as claimed in claim 1, wherein said judging step is performed on the basis of combination information of the mail address of the user and the mail address of a communication partner of the user which is predetermined by the user for translation, said translation judging step being antecedent to said electronic mail translating step (figure 3).

As to claim 3, Picoult teaches a provider machine comprising

Translation judging means configured to judge whether translation is required for a electronic mail based on at least one of sender data associated with the electronic mail and addressee data associated with the electronic mail (column 4, lines 19-27, Picoult discloses the data center determine if any translation is required); and

Electronic mail transmitting means for transmitting, when the translation judge judges that translation is required, to the address of a communication partner of an electronic mail or a terminal device of a user, a translated electronic mail containing a translation text obtained by translating through the provider a part or all of the contents of the electronic mail (column 4, lines 32-34, Picoult discloses once translation is effected, the message is routed to the identified destination device).

As to claim 4, Picoult teaches the provider machine as claimed in claim 3, further comprising:

Information storage means for storing at least combination information of the mail address of the user and the mail address of a communication partner of the user, which is predetermined by the user for translation (figure 2, item 230)

Translation judging means for judging whether the user-sending or user-addressed electronic mail corresponds to the electronic mail which is predetermined by the user to be translated, on the basis of the electronic mail

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addresses of a transmission source and a transmission destination of a user-sending electronic mail or user-addressed electronic mail and the combination information of said information storage means (figure 3).

As to claim 5, Picoult teaches the provider machine as claimed in claim 3, further comprising:

Information storage means for storing combination information of the mail address of the user, the mail address of a communication partner, which is predetermined by the user to be translated, and a language for a translation destination (figure 2, item 230);

translating means for translating a part or all of the contents of an electronic mail sent from the user or addressed to the user in the language of the translation destination on the basis of the combination information of said information storage means (figures 3 and 4); and

translated electronic mail creating means for creating a translated electronic mail containing a translated text translated by said translating means (figure 4, item 370).

As to claim 6, Nishino teaches the provider machine as claimed in claim 4, further comprising:

another information storage means for storing combination information of the mail address of the user, the mail address of a communication partner which is predetermined by the user to be translated, and a language for a translation destination (figure 5, item 500, the sender has the it "mail address" and the "mail address of the communication partner" stored in its memory, therefore it can be viewed as another "information storage means").

translating means for translating a part or all of the contents of an electronic mail sent from the user or addressed to the user in the language of the translation destination on the basis of the combination information of said another information storage means (figures 3 and 4); and

translated electronic mail creating means for creating a translated electronic mail containing a translated text translated by said translating means (figure 4, item 370).

As to claim 7, Picoult teaches a terminal device comprising at least translated electronic mail receiving means for receiving a translated electronic mail transmitted from said electronic mail transmitting means of said provider machine as claimed in claim 3 (figure 4, item 390).

As to claim 8, Picoult teaches a system comprising said provider machine as claimed in claim 3 (figure 1, item 120).

As to claim 9, Picoult teaches a medium for carrying a computer readable and executable program for executing said translating step in the electronic mail translating method as claimed in claim 1 (figure 4, item 370).

As to claim 10, Picoult teaches a medium for carrying a computer readable and executable program for executing said translation judging step in the electronic mail translating method as claimed in claim 2 (figure 3).

5. Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

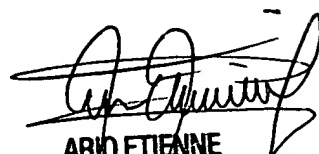
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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to El Hadji M Sall whose telephone number is 571-272-4010. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4010. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

El Hadji Sall
Patent Examiner
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